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## OFFICE OF PETITIONS

In re Application of:  
Yoshida. :  
Filed: 17 March, 1998 :  
Application No. 09/040,539 :  
Docket No.: JA997028US1 :

ON PETITION

This is a decision on the petitions filed herein on 8 November (and resubmitted on 14 and 15 November), 2002, under 37 C.F.R. §1.137(a)<sup>1</sup> and alternatively under 37 C.F.R. §1.137(b)<sup>2</sup> to revive the above-identified application,<sup>3</sup> and in light of the allegations therein also considered as

<sup>1</sup> A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

<sup>2</sup> Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 C.F.R. §1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

<sup>3</sup> The petition is styled as one alleging unavoidable delay (37 C.F.R. §1.137(a)), however, the fee paid was for a petition alleging unintentional delay (37 C.F.R. §1.137(b)), and Petitioner cites both provisions in his statement as to the nature of the delay (#3 of the petition). Therefore, as a matter of completeness, both provisions are addressed.

a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.<sup>4</sup>

The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition under:

- 37 C.F.R. §1.181 is **GRANTED**;
- 37 C.F.R. §1.137(a) is **DISMISSED as moot**, and
- 37 C.F.R. §1.137(b) is **DISMISSED as moot**.

#### BACKGROUND

The record indicates that:

- it appeared that applicant failed to reply timely and properly to the Notice of Non-Compliance (as to the absence of a corrected copy of the appealed claims as an appendix to the Appeal Brief) mailed on 5 September, 2002, and due on or before Tuesday, 8 October, 2002 (Monday 7 October having been a holiday);
- the application was deemed abandoned after midnight 8 October, 2002;
- it appears that no Notice of Abandonment was mailed before the instant petition was filed;
- Petitioner contends that the reply in question was timely filed, and supplies in that regard a copy of the US Postal Service (USPS) Express Mail Label No. EU314602817US, with a date-in set forth by the USPS clerk as "10-02-02" and a hand stamp "Oct. 7, 2002";

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<sup>4</sup> The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

**§1.181 Petition to the Commissioner.**

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. \* \* \*

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. \* \* \*

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. \* \* \*

- further, the papers in question now have been matched with the file and are stamped as received by the Office on 7 October, 2002.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>5</sup>

### CONCLUSION

Accordingly, the petition to:

- to withdraw the holding of abandonment as considered under 37 C.F.R. §1.181 hereby is **granted**;
- revive as to unavoidable delay under 37 C.F.R. §1.137(a) is **dismissed as moot**; and
- revive as to unavoidable delay under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The petition fee is waived and refunded pursuant to Petitioner's authorization to Deposit Account 09-0460.

The instant application is being forwarded to Technology Center 2100 before being forwarded in turn to the Board of Patent Appeals and Interferences.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>5</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).